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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Eric Jacobson

Serial No. 75/702,771

Request for Reconsideration

Jeffrey H. Greger of Mason, Maxon & Albright for Eric Jacobson.¹

Thomas J. Gleason, Trademark Examining Attorney, Law Office 109 (Ronald R. Sussman, Managing Attorney).

Before Seeherman, Chapman and Holtzman, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

¹ Applicant's power of attorney and correspondence address change filed December 13, 2002 has been entered in the record.

Eric Jacobson has timely requested reconsideration of the Board's November 13, 2002 decision affirming the Examining Attorney's refusal of registration.

Applicant asserts that the Board inappropriately concluded that prior registrations show that goods such as the registrant's lithographic prints or photographs and applicant's professional photography services² may emanate from a single source under a single mark, stating that none of the third-party registrations of record covers lithographic prints or lithography services. Applicant is correct that the third-party registrations do not specify that they are for lithographic prints. However, as applicant has acknowledged, lithographic printing may be used for such items as post cards and posters. Appeal brief, p. 5. In fact, the specimens from the file of the cited registration, which applicant had made of record, show that the registrant's lithographic prints include postcards and "mini-pictures." Thus, the third-party registrations referred to in our opinion at page 5, e.g., Registration No. 2,342,733 for, inter alia, postcards, posters and portrait photography, and No. 1,771,329 for

² Applicant's identification of services reads, in its entirety, "professional photography services, namely, customized individual photographic portrait and portfolio services exclusively for athletes, namely fitness and physique photography and athletic model photography."

calendars and portrait photography services for sports teams, demonstrate the relatedness of applicant's services and the goods in the cited registration.

Applicant also asserts that the Board erred in assuming that ordinary individuals would be interested in having lithographic prints made of their photographs. Even if this is correct, such individuals (including amateur athletes) may certainly wish to obtain photographic services of the type identified in applicant's application, i.e., photographic portrait and portfolio services for athletes. These individuals may encounter postcards, posters and other lithographic prints of photographs of athletes³ under the mark IMPACT, even if they do not wish to have their own photographs reproduced by a lithographic process, and they may also encounter applicant's photography services offered under the mark IMPACT PHOTOGRAPHY. Because of the similarity, indeed virtual identity of the marks (the only difference being the generic and disclaimed term PHOTOGRAPHY in applicant's mark), they might well assume an association between the goods and the services. Even when goods or services are not

³ The identification of goods in the cited registration is for "lithographic prints of photographs," and thus would encompass prints of photographs of athletes and athletic models.

competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993). Thus, while we acknowledge that there are differences between the applicant's services and the registrant's identified goods, the issue is not whether consumers will distinguish the goods and services, but whether they are likely to believe that, because of the similarities of the marks and the relatedness of the goods and services, the goods and services emanate from a single source. Moreover, in making this determination, as explained in the original decision and as discussed herein, any doubt on the issue of likelihood of confusion must be resolved in favor of the registrant.

Applicant also asserts that the Board erred in refusing to acknowledge evidence of the diluted nature of the mark IMPACT. The Board found that the evidence applicant submitted with its brief was untimely, and refused to take judicial notice that over 1,000 IMPACT marks exist in the records of the U.S. Patent and Trademark Office, and we adhere to that position, which is amply supported by case law. Applicant now states that it should not have been necessary for applicant to submit copies of over 1,000 registrations. We agree that such a submission

would have been not only unnecessary, but onerous. However, there is a distinction between not submitting any evidence of these registrations, and submitting a representative sample of them. Applicant did not provide the latter either. Instead, to support its contention that there are over 1,000 registrations for IMPACT marks, applicant is attempting to rely on the Examining Attorney's search statement page. We previously discussed the problems with this statement in terms of showing the existence of actual registrations, and will not do so again. Suffice it to say that the list does not show what marks were registered, or the goods or services, and the list is insufficient to show that the mark IMPACT is weak in terms of the specific goods and services at issue. Applicant itself acknowledges that "the numerous IMPACT formative marks were outside of Class 16 and not directly in the same field as the marks at issue," request for recon, p. 4. The weakness of a mark for goods and services which are far different from those at issue is not relevant to a determination of the strength of a mark for goods and services within the field.

As for the IMPACT formative marks which are within the relevant field, we discussed this evidence at length in our opinion, and will not do so again. As we said, the third-

party registrations are competent to show that IMPACT has a suggestive significance, but that suggestion is the same for both applicant's and the registrant's marks. And, although the cited registration may be entitled to a lesser scope of protection than would an arbitrary mark, that scope of protection is still broad enough to prevent the registration of the virtually identical mark IMPACT PHOTOGRAPHY for related services.

Finally, applicant has made the point that "at the Oral Argument, the Board noted that legal precedent in support of the premise that doubt in favor of publication could help the Board and the Board would be very interested in legal authority to support the very proposition that in arguably close cases, such as this case, that doubt could be resolved in favor of publication...." p. 8. In point of fact, the Board asked applicant's attorney if he could point to any legal support for his contention that any doubt on the issue of likelihood of confusion in this case should be resolved in applicant's favor. It appears from the request for reconsideration that applicant has not been able to find such legal support. Instead, applicant argues that there should be a distinction between inter partes and ex parte proceedings, and that in ex parte cases the Board should resolve doubt in favor of publication. Applicant

further states that "the Board has in its power the ability to make its own precedent and treat *ex parte* cases as it sees fit." p. 9. We are not persuaded by applicant's arguments. In fact, the Board is governed by, *inter alia*, the precedent established by our primary reviewing Court, the Court of Appeals for the Federal Circuit, and its predecessor courts. As indicated in the Pneumatiques decision cited at page 12 of the Board's decision, even in *ex parte* cases doubt must be resolved in favor of the registrant and prior user. That principle was reconfirmed by the Court of Appeals for the Federal Circuit as recently as January 2, 2003, in **In re Majestic Distilling Company, Inc.**, __F.3d__, __USPQ2d__, SN 75/622,781, in which it quoted the following statement from **In re Dixie Rests., Inc.**, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1535 (Fed. Cir. 1997):

[I]t is the duty of the PTO and this court to determine whether there is a likelihood of confusion between two marks. In re Apparel, Inc., 366 F.2d 1022, 1023, 151 USPQ 353, 354 (CCPA 1966). It is also our duty "to afford rights to registrants without constantly subjecting them to the financial and other burdens of opposition proceedings." Id.; see also In re Clorox Co., 578 F.2d 305, 308, 198 USPQ 337, 341 (CCPA 1978); McCarthy, [McCarthy on Trademarks and Unfair Competition] §23.24[1][d] (where PTO rejects an application under

section 1052(d), "it is no answer for the applicant to ask that the application be passed to publication to see whether the owner of the cited mark will oppose the registration"). Otherwise protecting their rights under the Lanham Act would be an onerous burden for registrants.

Finally, we note applicant's statement that it has contacted the registrant and commenced negotiations about a possible consent agreement. Applicant is reminded that Trademark Rule 2.142(g) provides that an application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under Section 6 of the Act or upon order of the Commissioner.

The Board, not being persuaded of any error in the rendering of its decision, hereby denies applicant's request for reconsideration.